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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78491274
Applicant	BORDER MEDIA PARTNERS, L.L.C.
Applied for Mark	DIGITAL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

IN RE: Border Media Partners, LLC
SERIAL NO.: 78/491274
FILED: September 29, 2004
MARK: DIGITAL
ATTORNEY
DKT NO.: 80559.00004

TO: TRADEMARK TRIAL AND APPEAL BOARD
P.O. Box 1451
Alexandria, VA 22313-1451

APPEAL BRIEF

CHANGE OF ATTORNEY FIRM NAME AND E-MAIL ADDRESS

Please change the firm name of applicant's attorney to Tuggey Rosenthal Pauerstein Sandoloski Agather LLP. The new e-mail address is: ip@trpsalaw.com. All other contact information remains the same.

BACKGROUND

Applicant has filed an application for the mark DIGITAL for radio broadcasting services (the "Mark"). The Examining Attorney initially rejected the mark for registration arguing the mark allegedly merely describes the services, citing Trademark Act (as amended) § 2(e)(1); 15 U.S.C. § 1052(e)(1); TMEP § 1209, et seq. Subsequently, the Examining Attorney went on to

argue that the mark is allegedly generic for applicant's services, citing Trademark Act Section 23(c), and 15 U.S.C. §1091(c).

ISSUES

Applicant appeals the Examiner's ruling and seeks a determination that the Mark is not merely descriptive of the described services, and registration of the Mark on the principle register be allowed. Alternatively, if the TTAB determines the Mark is merely descriptive, Applicant seeks a determination that the Mark is not generic for the described services, and registration of the Mark on the supplemental register be allowed.

ARGUMENTS AND AUTHORITIES

Merely Descriptive

The U.S. Patent and Trademark Office has the burden to establish a prima facie case that the proposed mark is merely descriptive. In re Etablissements Darty et Fils, 759 F.2d 15 (Fed. Cir. 1985). Doubts concerning the descriptiveness of the mark are to be resolved in favor of the applicant during ex parte prosecution. In re Micro Instrument Corp., 222 U.S.P.Q. 252, 255 (TTAB 1984); In re LRC Products, Ltd., 223 U.S.P.Q. 1250, 1252 (TTAB 1984).

A mark is descriptive if it describes a desirable characteristic, purpose, function, quality or use of any of the goods or services to which it is applied. In re Blue Cross Lab, Inc., 195 U.S.P.Q. 583 (TTAB 1977). A term is "merely descriptive" of goods or services if it **immediately describes** an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811 (C.C.P.A. 1978); In re Pennzoil Products Co., 20 U.S.P.Q.2d 1753 (TTAB 1991). This situation does not exist with the subject application.

The Examiner has argued that DIGITAL, "...merely serves to inform the public that it broadcasts digital audio signals," and has offered as evidence partial definitions from Wikipedia and Merriam-Webster's on-line dictionaries. The Applicant disagrees that the mark DIGITAL is merely descriptive of radio broadcast services. DIGITAL has a variety of meanings and is thus not merely descriptive of the goods/services presented in the application.

In evaluating a rejection based on descriptiveness, it is important to focus on the language of the Lanham Act. As in so many other areas, the language used in framing a rejection, or other requirement, can tend to diverge from the statute. The federal Lanham Act requires that a mark be "merely descriptive" before proof of secondary meaning is required. If a composite mark is not 100% descriptive, then the mark as a whole is not "merely" descriptive. Application of *Richardson, Inc.*, 511 F.2d 559 (C.C.P.A. 1975); Application of *Hercules Fasteners, Inc.*, 203 F.2d 753 (C.C.P.A. 1953). This qualification must be kept in mind when evaluating a mark for descriptiveness.

The dictionary definitions presented by the Examiner actually support Applicant's position. The discussion by Wikipedia does not offer a single hint of radio broadcasting services, and certainly does not provide evidence that "digital" is merely suggestive of them. Instead, Wikipedia refers to fingers, data storage and transfer, internal workings of an instrument, and kinds of displays.

Likewise, Meriam-Webster's definition does not support the Examiner's argument. Again, many unrelated definitions are presented that lead to the conclusion that "digital" is not merely descriptive of radio broadcasting services. The definition cited by the examiner is the sixth listed definition, the others generally having to do with fingers and calculations. Furthermore, the cited definition, while including reference to sound waves, specifically refers to

a recording method and how they are represented “as on magnetic tape.” Again, there is no logical bridge between “digital” and its definitions, and “radio broadcasting services.” Thus, at the very least a mental pause is required to form any connection between the two.

Given the various definitions, DIGITAL has different connotations to different people over and above any alleged descriptive characteristics. If a mark is susceptible of a double meaning or multiple meanings, it is not merely descriptive. In re David Crystal, Inc., 145 U.S.P.Q. 95 (TTAB 1965); In re Grand Metropolitan Foodservice, Inc., 30 U.S.P.Q.2d 1974 (TTAB 1994) (the mark “MUFFUNS” (Stylized) overcame a descriptiveness refusal because it projects a dual meaning or suggestiveness -- that of muffins and of the “fun” aspect of applicant’s food product).

If a mark is a word combination whose import could not be grasped without some measure of imagination and a “mental pause,” then the mark is suggestive rather than descriptive. In re Shutts, 217 U.S.P.Q. 363, 364-65 (TTAB 1983). “DIGITAL” falls in this category; therefore, the refusal of registration should be withdrawn. Because the line between merely descriptive and only suggestive terms is “so nebulous,” the Trademark Trial and Appeal Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination. In re Conductive Systems, Inc., 220 U.S.P.Q. 84 (TTAB 1983) (doubts under Section 2(e) about the merely descriptive nature of the term are resolved in favor of the applicant).

Accordingly, whatever information about the product or service given by the mark DIGITAL is indirect or vague, indicating that the term is being used in a “suggestive,” not descriptive, manner. A mark is often said to be suggestive if it requires imagination, thought,

and perception to reach a conclusion as to the nature of the goods or services in connection with which it is used. *West & Co. v. Arica Institute, Inc.*, 557 F.2d 338 (2d Cir. 1977).

The Examiner has summarized Applicant's argument as simply that the definition presented by the Examiner is not the primary, nor the first listed definition in the dictionary. This is an incorrect interpretation of the whole of Applicant's argument. As Applicant has previously argued, the mark DIGITAL is not merely descriptive of Applicant's services because consumers will not connect the mark with the services, thus it is not descriptive.

The Examiner has stated that the "fact that a term may have different meanings in other contexts is not controlling." However, the Examiner leaves the argument with that unsupported statement. The Examiner seems to imply that other meanings are irrelevant, which is not correct.

TMEP 1209.03(e) discusses instances in which a term has more than one meaning and states that multiple definitions may not be controlling, but that "descriptiveness must be determined in relation to the goods or services for which registration is sought." This is where the Examiner's argument and evidence fall short. The examiner, in the first office action, only referred to a dictionary definition, and in the final office action attached 12 references to digital radio from the Internet (and half of those are foreign references). Interestingly, a Google search for "digital" returned a reported 3.1 billion hits, yet to applicant's knowledge, there is only one other entity using the term "Digital" as a portion of a trademark for radio broadcasting services. Interestingly, Registration 2666824 for THE DIGITAL GENERATION is registered on the primary register without any disclaimer. Additionally, the references cited by the Examiner are not relevant to the listed services -- at best, they could be argued to be related to radio hardware. i.e. The equipment used to broadcast the radio signal. The type of hardware used by a station is

invisible to radio listeners, and irrelevant when it comes to causing an association between the mark and the relevant services being provided to the relevant consumer group.

The only connection between the mark and the services that the Examiner has made is in the original office action in which it was stated that the mark, "...merely serves to inform the public that it broadcasts digital audio signals." Despite the requirement that the PTO establish a prima facie case that the proposed mark is merely descriptive, there has been no evidence supplied that the mark would cause the public to believe that Applicant broadcasts digital audio signals. In re Establissemments Darty et Fils, 759 F.2d 15 (Fed. Cir. 1985).

Generic

The TMEP is very clear regarding the definition of generic terms in §1209.01(c). It states that, "Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services." Citing In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); In re American Fertility Society, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

TMEP §1209.01(c)(i) goes on to describe the two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public.

The U.S. Patent and Trademark Office has the burden of proving that a term is generic by clear evidence. In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d

1141 (Fed. Cir. 1987). TMEP §1209.01(c)(i). In this office action, although the Examiner cites that evidence is attached, there is in fact no evidence, attached or otherwise, that the Mark is generic for the services listed.

The Examiner's only statement in the office action that addresses the mark somewhat specifically and not genericness in general is that DIGITAL is, "the common descriptive name for the type of radio broadcasting being provided. As such, it is generic for an important feature of the services."

Merriam-Webster's On-Line dictionary found at <http://www.m-w.com/dictionary.htm>, upon a search for "digital" lists seven (7) entries: digital, digital camera, digital computer, digital subscriber line, digital versatile disc, digital video disc, and personal digital assistant. For the main entry "digital," Merriam-Webster gave the following definitions:

Main Entry: **dig-i-tal**

Pronunciation: 'di-j&-t&l

Function: adjective

Etymology: Latin digitalis

1 : of or relating to the fingers or toes <digital dexterity>

2 : done with a finger <a digital rectal examination>

3 : of, relating to, or using calculation by numerical methods or by discrete units

4 : of, relating to, or being data in the form of especially binary digits <digital images> <a digital readout>; especially : of, relating to, or employing digital communications signals <a digital broadcast> -- compare ANALOG 2

5 : providing a readout in numerical digits <a digital voltmeter>

6 : relating to an audio recording method in which sound waves are represented digitally (as on magnetic tape) so that in the recording wow and flutter are eliminated and background noise is reduced

7 : ELECTRONIC <digital devices>; also : characterized by electronic and especially computerized technology <the digital age>

- **dig·i·tal·ly** /-t^{&l}-E/ adverb

The Examiner's sole argument that DIGITAL is, "the common descriptive name for the type of radio broadcasting being provided.," has no support in Merriam-Webster, which in its definitions of "Radio" and "broadcasting" makes no mention of "digital."

The discussion by the on-line encyclopedia Wikipedia is in line with Merriam-Webster and does not offer a single hint of radio broadcasting services. Instead, Wikipedia refers to fingers, data storage and transfer, internal workings of an instrument, and kinds of displays.

Likewise, the American Heritage Dictionary found on-line at <http://www.bartleby.com/61/31/F0313100.html> returns 38 entries for "digital:"

1) DAT. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...digital audiotape...

2) DSS. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...digital satellite system...

3) DVR. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...digital video recorder...

4) PDA. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...1. personal digital assistant 2. public display of affection...

5) ADSL. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Asynchronous Digital Subscriber Line...

6) personal digital assistant. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...abbr. PDA A lightweight, hand-held, usually pen-based computer used as a personal organizer....

- 7) ISDN. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Integrated Services Digital Network...

- 8) digital. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...to, or resembling a digit, especially a finger. 2. Operated or done with the fingers: a digital switch. 3. Having digits. 4. Expressed in numerical form, especially...

- 9) digital satellite system. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...abbr. DSS A system in which a satellite dish receives a digital signal, decodes the signal, and passes it to a television, radio receiver, or computer....

- 10) digital computer. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A computer that performs calculations and logical operations with quantities represented as digits, usually in the binary number system....

- 11) digital photography. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A method of photography in which an image is digitally encoded and stored for later reproduction....

- 12) digital recording. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...1. A method of recording in which portions of sound waves are converted into numbers and stored for later reproduction. 2. A record, tape, or disk that is recorded...

- 13) digerati. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...People who are knowledgeable about digital technologies such as computer programming and design: the chasm between the high claims of the digerati and the misadventures...

- 14) webcam. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A camera designed to take digital photographs and transmit them over the Internet or other network. web + cam(era)....

- 15) idle character. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...An alphanumeric or digital character that is transmitted over a communications line but does not appear in the output of the receiving terminal....

- 16) optical disk. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A plastic-coated disk that stores digital data, such as music or text, as tiny pits etched into the surface and is read with a laser scanning the surface. Also called...

- 17) modem. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A device for transmitting usually digital data over telephone wires by modulating the data into an audio signal to send it and demodulating an audio signal into data...

- 18) MPEG. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...1. Any of a set of standards established for the compression of digital video and audio data. 2. A file of digital video and audio data that has been so compressed:...

- 19) JPEG. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Computer Science 1. The standard algorithm for the compression of digital images. 2. A digital image stored as a file so compressed: e-mailed me a JPEG of her house....

- 20) readout. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Computer Science Presentation of data, usually in digital form, from calculations or storage....

- 21) optical scanner. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A device that converts printed images and text into digital information that can be stored as a computer file and processed by graphics software....

- 22) optical character recognition. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...abbr. OCR 1. The electronic identification and digital encoding of printed or handwritten characters by means of an optical scanner and specialized software. 2. The...

- 23) MIDI. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Inflected forms: pl. MID·Is1. A standard for representing musical information in a digital format. 2. Software that conforms to this standard, used for composing...

- 24) LED. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...A semiconductor diode that converts applied voltage to light and is used in digital displays, as of a calculator. l(ight)-e(mitting) d(iode)....

- 25) liquid-crystal display. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...abbr. LCD A low-power flat-panel display used in many laptop computers, calculators and digital watches, made up of a liquid crystal that is sandwiched between layers...

- 26) digitize. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...Inflected forms: dig·i-tized, dig·i-tiz·ing, dig·i-tiz·es To put (data, for example) into digital form. digi·ti-zation (-ti-zshn) -NOUNdigi-tizer -NOUN...

- 27) magnetic disk. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...a hard disk, or a removable cartridge, that is covered with a magnetic coating on which digital information is stored in the form of microscopically small, magnetized...

- 28) aliasing. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...computer graphics because the resolution is limited or diminished. 2. The static distortion in digital sound caused by a low sampling rate....

- 29) clock 1. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...especially a mechanical or electronic device having a numbered dial and moving hands or a digital display. 2. A time clock. 3. A source of regularly occurring pulses...

- 30) cassette. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...them, often used in audio and video recorders and players and as a medium for storing data in digital form. 2. A lightproof cartridge containing photographic film...

- 31) technology. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...and material used to achieve a commercial or industrial objective. 2. Electronic or digital products and systems considered as a group: a store specializing in office...

- 32) digitalin. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...that is obtained from the seeds of the common foxglove. 2. One of several mixtures of digitalis glycosides that are extracted from the leaves or seeds of the common...

- 33) retronym. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...development, as acoustic guitar in contrast to electric guitar or analog watch in contrast to digital watch. retr(o)- + -onym...

- 34) print. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...3a. Lettering or other impressions produced in ink as from type by a printing press or from digital fonts by an electronic printer. b. Matter so produced; printed...

- 35) virtual. The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

...around the use of e-mail, webpages, and other networked resources. The adjectives virtual and digital and the prefixes e- and cyber- are all used in various ways...

- 36) Editorial and Production Staff. The American Heritage Dictionary of the English Language, Fourth Edition. 2000

...Inc. Galápagos Design Group Inc. Pre-Press Company, Inc. Quebecor World, Inc. (Digital Division-Lexington)...

- 37) Usage in The American Heritage Dictionary. The American Heritage Dictionary of the English Language, Fourth Edition. 2000

...General American. 29 One class of these new entries deserves special mention. Digital technologies have had a sweeping effect on the language in recent years, as...

- 38) Usage in The American Heritage Dictionary. The American Heritage Dictionary of the English Language, Fourth Edition. 2000

...and General American. 29 One class of these new entries deserves special mention. Digital technologies have had a sweeping effect on the language in recent years,...

Again, there is no logical bridge between “digital” and its definitions, and “radio broadcasting services.” The American Heritage Dictionary returns no entries for either “digital radio” or “digital broadcast.”

A Google search for “digital” does not return any mention of radio broadcasting for the first 100 entries (although a digital podcast is mentioned in the 35th result). Applicant did not continue looking through the Google returns to find when, or if, “digital radio” is ever mentioned.

The Examiner makes a point to say that “A term need not relate solely to the name of the goods or services in order to be held incapable of serving as an indicator of origin.” However, given the various definitions, none of which identify DIGITAL with radio broadcasting, it is a far stretch to allege DIGITAL is merely descriptive of radio broadcasting services, to say anything of generic for them.

As discussed above, “DIGITAL” has multiple meanings and is suggestive. The consumer’s mind would not jump instinctively from a contemplation of this mark to knowledge of a quality or characteristic of the goods or services or even that it was used on or in connection with radio broadcasting services.

The Examiner's statement that DIGITAL "is the common descriptive name for the type of radio broadcasting being provided," is unsupported by the evidence. In fact, by the Examiner's reasoning for "radio broadcasting being provided," the Applicant's services would not be services at all, but rather goods.

If the test for generic found in the TMEP is applied to DIGITAL for radio broadcasting services, the requisite definition is not met. In order to be deemed generic, DIGITAL must be understood by the relevant public to be the designation that primarily refer to that class of services. This test is simply not met. The public does not hear "digital" and think "radio broadcasting services."

CONCLUSION

Applicant's mark DIGITAL is not merely descriptive, nor generic, of Applicant's services because there is no link, or only a tenuous link, between the mark and the services. "DIGITAL" has multiple meanings and is suggestive. The consumer's mind would not jump instinctively from a contemplation of this mark to knowledge of a quality or characteristic of the goods or services or even that it was used on or in connection with radio broadcasting services.